

REMARKS

Claims 1-7 are pending in the present application.

I. PRIOR ART REJECTION

Claims 1-7 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,085,201 (Tso). This rejection is traversed.

The Examiner's reasoning presented in paragraph 2 of the Non-final Office Action is substantially similar to that presented in the previous office action dated September 28, 2004. One difference is the addition of several arguments (see paragraph 3 of Office Action) related to the temporary memory means, which was added to claims 1 and 7 in the Preliminary Amendment filed on March 28, 2005. In these additional arguments, the Examiner asserts that Tso includes a temporary memory means that temporarily stores one or more portions of the received mail selected by a contents selecting means. Specifically, the Examiner relies on column 3, lines 36-38 of Tso. This section of Tso merely discloses a mail database 3 that stores the e-mail messages. The database 3 does **not** store **portions** of contents of received e-mail **selected by user** by a contents selecting means. Rather, the database 3 stores **all of the e-mail messages** in the e-mail system 1, as shown in Fig. 1.

The Examiner also asserts that Tso teaches the claimed reply mail preparing means that couples the portions of e-mail stored in a temporary memory means. As presented above, Tso does not teach the claimed temporary memory means. Therefore, Tso cannot teach the claimed reply mail preparing means. Further, the newly relied on

sections of Tso (column 7, lines 28-31 and column 6, lines 6-15) merely teach that the template engine 5 may store suggested templates retrieved from the template database 4, and a special input form that allows the user to select a time by clicking spin buttons, respectively.

The Examiner's new arguments and newly cited section of Tso do not show that Tso teaches to use portions of the received e-mail in the reply e-mail, as in the claimed invention. In the Final Office Action dated September 28, 2004, the Examiner asserted that the reply e-mail of Tso includes at least one or more portions of the received e-mail. Specifically, the Examiner made the following assertion:

Tso teaches of 'context appropriate sentences to include in the outgoing text message **based on** the actual content of the input text passage' (see col. 2, lines 65-67), wherein the input text passage can be '[a] portion of a received text message' (see col. 2, lines 61-64). (Emphasis Added).

In presenting these quoted passages of Tso, the Examiner has left out a critical portion of this quoted section of Tso, and rearranges some of the phrases of this quoted section of Tso which mischaracterizes the true meaning. In fact, when the entire text of this quoted section of Tso is examined, it is clear that this section shows unequivocally that Tso does not anticipate the claimed invention. The entire portion of this section of Tso is reproduced below.

Given an input text passage, such as a portion of a partially-compressed outgoing text message **or a portion of a**

received text message¹, the template engine can suggest one or more predefined, context-appropriate sentences to include in the outgoing text message based upon the actual content of the input text passage.

The key phrase in this portion of Tso quoted by the Examiner is the phrase “based upon” and “predefined.” When considering the entire portion of this quote, it is clear that the template engine suggests **predefined** context-appropriate sentences **based upon** the actual content of the input text passage. That is, Tso does not use portions of the received e-mail in the reply e-mail, as in the claimed invention. Rather, Tso teaches that the template suggests predefined text **based upon** the input text message. The fact that the context-appropriate sentences are **predefined** means that portions of the received e-mail are not used in the reply e-mail, since the received e-mail cannot be known before hand.

The sections of Tso relied on by the Examiner do not teach or suggest to use portions of the received e-mail in the reply e-mail, and certainly do not teach or suggest having a user select portions of a received mail and coupling the user selected portions of the received mail with answer examples, as recited in the claimed invention. Rather, these sections of Tso merely teach to include **predefined**, context-appropriate sentences in the outgoing message **based on** the content of the input text message. In the system taught by Tso, the **entire contents** of the replay mail is formed from the template (see column 5, line 66 – column 6, line 33). Tso only teaches to use the contents of the received e-mail to **choose the template** (see column 4, line 33 – column 5, line 53).

¹ This highlighted section of the quoted portion of Tso was inadvertently left out in the presentation of this section of Tso in the Response filed on December 28, 2004.

Portions of a received e-mail are not selected by the user, and are not coupled with answer examples such that the contents of the received e-mail are inserted into the reply e-mail.

There is no indication in Tso that a user must pick from one or more portions of a received e-mail, and that the reply e-mail must include one or more portions of the received e-mail, as shown in Figs. 8-11 of the present invention. Quite to the contrary, Tso merely teaches to create the outgoing text message using **templates** that are selected **based upon** the input text message (see column 4, line 32 – column 5, line 17). As presented above, the example relied on by the Examiner is not disclosed in Tso. Rather, it is a hypothetical example created by the Examiner.

In sum, Applicant submits that Tso does not teach or suggest a system that performs the functions of: (1) requiring a user to select one or more portions from a received mail; and (2) coupling the selected contents of the received mail with selected answer examples.

During the telephone interview conducted with Examiner Won on March 10, 2005, Examiner Won asserted that the text in the template of Tso is dynamic. Applicant submits that there are no portions of Tso that support the Examiner's position that the templates of Tso include actual portions of the received e-mail. In fact, column 5 line 61 through column 6, line 34 seems to show that all of the text in the template is **predefined**. Even the "customized" templates described in column 6, line 42-65 consist of other **predefined** text selections. Specifically, when a template is "customized" in Tso, the future uses of that template include the customized revision (see column 6, lines 62-64).

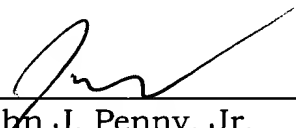
Therefore, for the reasons presented above, Applicant submits that the Examiner has misread the Tso reference and that Tso does not anticipate claims 1-7.

Based on the foregoing, Applicant submits that the present application is in condition for allowance and allowance is respectfully solicited. If the Examiner believes that the prosecution of this case could be expedited through a telephone interview, he is kindly invited to contact the undersigned at the phone number listed below.

Applicant believes that no additional fees are due for the subject application. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge Deposit Account No. 04-1105.

Respectfully Submitted,

Date: August 16, 2005
Customer No.: 21874



John J. Penny, Jr.
(Reg. No.: 36,984)
EDWARDS & ANGELL, LLP
P.O. Box 55874
Boston, Ma 02205
Tel: (617) 517-5549
Fax: (617) 439-4170